

REMARKS

The undersigned believes that this amendment should place the application into condition for allowance.

With regard to the new claims, no new matter has been added. It is contemplated that the currently amended independent claims of the application relate to a method or apparatus in which adaptation data is applied either to games content as first installed and implemented on the mobile device or to subsequent adaptations thereof. New claims 46-51, 53, and 55 reflect this second possibility and are supported throughout the specification (*see, e.g.*, paragraph 30 of the substitute specification filed May 16, 2005). New claims 52 and 53 are similar in some respects to previously pending claims but specify a computer-readable medium. Full support can be found throughout the original specification and drawings (*see, e.g.*, Fig. 4). The amendments to the previously pending claims likewise do not add new matter.

As set forth in the previous response, it is submitted that Peng and Srinivasan do not render obvious any previously pending claim. In any case, the Peng and Srinivasan references do not render obvious the subject matter of previously pending claims 42 and 44 (now recast in independent form) and of the other claims of the application. The Office Action, in addressing claim 42, cited Peng's disclosure at column 1, lines 35-43 and column 15, lines 15-20. Applicants respectfully disagree. The Peng patent does include an oblique reference to games at column 1, line 42, but this does not constitute a disclosure of software for modifying games content. Nor does Peng's disclosure at column 15 support the rejection. Here, Peng purports to disclose certain features of an

application “update process,” but there is no disclosure of software for modifying games content.

The Peng provisional application is similarly deficient. The Examiner has already noted the provisions of M.P.E.P. 2136.03, which require in this case the Peng provisional application to support the subject matter relied upon to make the rejection. Here, such support is not seen, which in retrospect is not surprising because the Peng patent itself is deficient. In light of this deficiency, which is not overcome by Srinivasan, withdrawal of the rejection is required.

There is an additional basis for withdrawal of the Section 103 rejection. The Examiner has failed to demonstrate that the Peng provisional application supports the claimed Peng invention under 35 U.S.C. Section 112. As noted in *In re Wertheim*, 646 F.2d 527 (C.C.P.A. 1981) and subsequently in the M.P.E.P., it is incumbent upon the office in this case to demonstrate that the Peng provisional application supports the invention claimed in the Peng patent. The *Wertheim* court so held:

If, for example, the PTO wishes to utilize against an applicant, a part of that part of that patent disclosure found in that application filed earlier than a date of the application which became the patent, it must demonstrate that the earlier-filed application contains §§ 120/112 support for the invention claimed in the reference patent.

646 F.2d at 537. The M.P.E.P. explicitly notes this requirement:

In order to carry back the 35 U.S.C. Section 102(e) critical date of the U.S. patent reference to the filing date of the parent application, the U.S. patent reference must have a right of priority to the earlier date under 35

U.S.C. 120 or 365 (c) and the parent application must support the invention claimed as required by 35 U.S.C. 112, first paragraph.

M.P.E.P. 2161.03. Subsection III of this section clarifies that “the claims in a U.S. application are entitled to a benefit of ... the filing date of a provisional application if the corresponding provisional application supports the claims in a manner required by 35 U.S.C. 112, first paragraph.” Accordingly, the M.P.E.P has recognized that the *Wertheim* rule applies to prior provisional applications in addition to Section 120 continuing applications.

In this case, as earlier noted, the Peng provisional application is a jumbled collection of documents that bears little resemblance to the issued Peng patent. The Examiner has not shown that any claim to the Peng patent is supported by the Peng provisional, and accordingly, has failed to demonstrate that Peng may be relied upon as prior art.

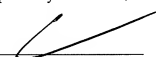
Of course, in any case, in light of the failure of the Peng patent to disclose the subject matter previously pending in claims 42 and 44, the Peng reference would be deficient even if it were available as prior art. Nothing in the Srinivasan reference overcomes this deficiency. Accordingly, the pending claims are patentable over the cited art.

For these reasons, withdrawal of the rejections and allowance of the application are respectfully solicited.

Respectfully submitted,

Dated: June 11, 2008

By:


Allen E. Hoover

Reg. No. 37,354
BANNER & WITCOFF, LTD.
10 South Wacker Drive
Suite 3000
Chicago, IL 60606
Tel: (312) 463-5000
Fax: (312) 463-5001